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**JAN 25 2007**

**OFFICE OF PETITIONS**

In re Application of :  
Ingram et al. :  
Application No. 09/620,060 : DECISION ON APPLICATION  
Filed: July 21, 2000 : FOR  
Atty Docket No. 49950-59911CON: PATENT TERM ADJUSTMENT

This is a decision on the "PETITION FOR REVIEW OF A PATENT TERM EXTENSION PURSUANT TO 37 C.F.R. §§ 1.181 AND 1.704(c)(8)" filed November 9, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to one thousand sixty-five (1065) days or at least eight hundred twenty-three (823) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is two hundred eighteen (218) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 9, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On November 9, 2006, applicants timely submitted an application for patent term adjustment (with required fee)<sup>1</sup>. Applicants do not dispute the period of

<sup>1</sup> PALM records indicate that the Issue Fee payment was also received on November 9, 2006.

reduction of 292 days for applicant delay. Rather, applicants argue that the period of adjustment for examination delay should be 1357 days or 1115 days. As such, the patent term adjustment would be 1065 (1357 - 292) or 823 (1,115 - 292) days.

Specifically, applicants first assert entitlement to a period of adjustment, pursuant to 37 C.F.R. § 1.702(a)(1)<sup>2</sup>, for the Office's failure to respond to a reply under 35 U.S.C. §132 not later than four months after the date on which the reply was filed. Applicants calculate this period as 1357 days, from November 22, 2002 (the date that is four months after their filing of a terminal disclaimer on July 22, 2002) to August 9, 2006.

Alternatively, applicants assert entitlement to a period of adjustment, pursuant to 37 C.F.R. § 1.702(b), for the Office's failure to issue the patent within three years of the actual filing date. Applicants calculate this period as at least 1,115 days, from July 21, 2003 to August 9, 2006, the date of mailing of the Notice of Allowance.

(It is unclear why in this petition applicants reference § 1.704(c)(8) as this is a section pertaining to reducing the patent term adjustment for Applicant delay. Further, no correction of the PTA is required with respect to § 1.704(c)(8)).

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

As for applicants' request for at least 1115 days of patent term adjustment on the basis of the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the

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<sup>2</sup> Applicants should have cited 37 C.F.R. § 1.702(a)(2) for this delay.

request. Patentees may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

As to applicants' request for 1357 days of patent term adjustment on the basis of the Office's failure to take action within four months, applicants are correct that correction is required. The Office mailed an Office action under section 132 on August 15, 2002, within four months, of applicants' reply filed June 24, 2002. However, the Notice was not mailed to the correspondence address of record (but to an attorney not of record). The record supports a conclusion that this was due to an error on the part of the Office in mailing the Office action to applicants. Accordingly, a corrected Notice of Allowance was mailed on August 9, 2006.

Thus, the Office's delay should be calculating using the August 9, 2006 date. However, the period of delay is 1,385 days, not 1,357 days. Applicants' response was received on June 24, 2002. Thus, the period of adjustment is 1,385 days, the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, October 25, 2002, and ending on the date of mailing of a Notice of Allowance, August 9, 2006.

However, a review of the record reveals a further basis for reduction of the patent term adjustment, pursuant to 37 CFR 1.704(c)(4). No response to the Notice of Allowance mailed August 15, 2002 was considered timely filed by the Office and the application became abandoned. On December 26, 2002, the Office mailed a Notice of Abandonment. However, the record confirms that the Notice of Abandonment (as was the Notice of Allowance) was mailed to an improper address.

Petitioner is advised that if a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the notice of abandonment, any patent term adjustment will be reduced under the provisions of 37 CFR 1.704(c)(4). If applicant does not receive the notice of abandonment, any patent term adjustment may be reduced under the provisions of 37 CFR 1.704(a) by a period equal to the period of time during which the applicant "failed to engage in reasonable efforts to

conclude prosecution" (processing or examination) of the application, in which case any period of adjustment shall be reduced by the number of days, if any, beginning on the day after the date that is twelve months from the date of applicant's filing or submission of correspondence with the USPTO for which further action by the USPTO can reasonably be expected and ending on the filing date of a grantable petition to withdraw the holding of abandonment. *Untimely Filing of Petitions under 37 CFR 1.181(a) to Withdraw Holdings of Abandonment*, 1283 OG 147 (June 22, 2004).

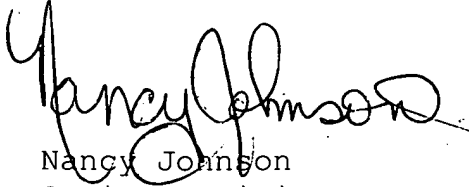
In this instance, on July 22, 2002, applicants filed a terminal disclaimer for which applicants state they expected further action (i.e., to receive a Notice of Allowance in due course). The Notice of Abandonment was not mailed to applicants at the proper correspondence address. Accordingly, it is being treated as never received by applicants. Applicants filed multiple status inquiries and changes of correspondence address. However, applicants never filed a petition to withdraw the holding of abandonment. The Office withdrew the abandonment on December 13, 2005. Accordingly, a period of reduction of 875 days for the period beginning on July 23, 2003, the day after the date twelve months from the date of filing of the terminal disclaimer, to December 13, 2005.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is two hundred eighteen (218) days.

The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to petitioner's Deposit Account, as authorized. No additional fees are required.

The application is being forwarded to the Office of Patent Publication so that a patent can be issued. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" written in a larger, more prominent script than the last name "Johnson".

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of Revised PAIR Screen

Day : Saturday  
Date: 1/20/2007

# PALM INTRANET

Time: 16:09:51

## PTA Calculations for Application: 09/620060

Application Filing Date:	07/21/2000	PTO Delay (PTO):	0
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	292
Post-Issue Petitions:	0	Total PTA (days):	218
PTO Delay Adjustment:	510		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
63	01/20/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	1385		
62	01/20/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		875	
61	01/20/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		875	
60	01/20/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	875		
54	08/09/2006	MAIL CORRECTED NOTICE OF ALLOWANCE			
53	08/03/2006	CORRESPONDENCE ADDRESS CHANGE			
52	05/23/2006	RECEIPT INTO PUBS			
51	05/03/2006	WORKFLOW - FILE SENT TO CONTRACTOR			
50	04/25/2006	EXPORT TO INITIAL DATA CAPTURE			
49	12/13/2005	CORRECTED NOTICE OF ALLOWANCE			
48	12/13/2005	WITHDRAW PUBLICATION/PRE-EXAM ABANDON			
47	12/13/2005	CASE DOCKETED TO EXAMINER IN GAU			
46	11/01/2005	CORRESPONDENCE ADDRESS CHANGE			
45	08/01/2005	MISCELLANEOUS INCOMING LETTER			
44	11/09/2004	MISCELLANEOUS INCOMING LETTER			
43	08/18/2004	CORRESPONDENCE ADDRESS CHANGE			
42	12/26/2002	MAIL ABANDONMENT FOR FAILURE TO PAY ISSUE FEE			
41	12/26/2002	ABANDONMENT FOR FAILURE TO PAY ISSUE FEE			
40	07/21/2000	WORKFLOW - DRAWINGS FINISHED			
39	07/21/2000	WORKFLOW - DRAWINGS MATCHED WITH FILE AT CONTRACTOR			
38	10/14/2002	RECEIPT INTO PUBS			
37	08/16/2002	WORKFLOW - FILE SENT TO CONTRACTOR			

36	08/16/2002	WORKFLOW - FILE SENT TO CONTRACTOR			
35	08/16/2002	RECEIPT INTO PUBS			
34	08/15/2002	DISPATCH TO PUBLICATIONS			
33	08/15/2002	MAIL NOTICE OF ALLOWANCE			
32	08/15/2002	MAIL NOTIFICATION OF TERMINAL DISCLAIMER - ACCEPTED			
31	08/14/2002	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
30	08/12/2002	NOTICE OF ALLOWABILITY			
29	07/22/2002	NOTIFICATION OF TERMINAL DISCLAIMER - ACCEPTED			
28	07/22/2002	TERMINAL DISCLAIMER FILED		28	25
27	07/11/2002	X-PRE-LEGAL COMPLETE AMENDED CASE			
26	07/11/2002	DATE FORWARDED TO EXAMINER			
25	06/24/2002	RESPONSE AFTER NON-FINAL ACTION		10	19
24	07/11/2002	CORRESPONDENCE ADDRESS CHANGE			
23	07/11/2002	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
22	04/27/2001	PAYMENT OF ADDITIONAL FILING FEE/PREEEXAM		121	4
21	03/19/2002	X-PRE-LEGAL COMPLETE AMENDED CASE			
20	03/01/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		17	15
19	03/14/2002	MAIL NON-FINAL REJECTION			
18	03/13/2002	X-POST-LEGAL COMPLETE REJECTION			
17	03/13/2002	NON-FINAL REJECTION			
16	02/28/2002	DATE FORWARDED TO EXAMINER			
15	02/12/2002	RESPONSE TO ELECTION / RESTRICTION FILED		116	11
14	02/12/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
13	02/07/2002	CASE DOCKETED TO EXAMINER IN GAU			
12	07/19/2001	CASE DOCKETED TO EXAMINER IN GAU			
11	07/19/2001	MAIL RESTRICTION REQUIREMENT			
10	07/19/2001	REQUIREMENT FOR RESTRICTION / ELECTION			
9	07/16/2001	CASE DOCKETED TO EXAMINER IN GAU			
8	05/18/2001	CASE DOCKETED TO EXAMINER IN GAU			
7	05/15/2001	APPLICATION DISPATCHED FROM OIPE			
6	05/11/2001	APPLICATION IS NOW COMPLETE			
5	05/11/2001	CORRESPONDENCE ADDRESS CHANGE			

4	09/27/2000	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	09/20/2000	CORRESPONDENCE ADDRESS CHANGE			
2	08/09/2000	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/21/2000	INITIAL EXAM TEAM NN			

**Search Another: Application#**

**Search**

### **EXPLANATION OF PTA CALCULATION**

### **EXPLANATION OF PTE CALCULATION**

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